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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,539	01/02/2002	Toshiharu Yamashita	Q67942	5593

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EXAMINER

BOLDEN, ELIZABETH A

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,539

Applicant(s)

YAMASHITA ET AL.

Examiner

Elizabeth A. Bolden

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1755

DETAILED ACTION

Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

Election/Restrictions

Applicant's election without traverse of Group I, claims 1, 2, and 4-7 in Paper No. 10 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "substantially does not comprise CuO" renders the claim indefinite because it is unclear how much CuO is permissible since "substantially" has not been defined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 1755

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Prassas, U.S. Patent 4,891,336 in view of Borrelli et al., U.S. Patent 5,252,524.

Prassas teaches a high index photochromic glass having overlapping ranges of components with instant claims 1, 2, and 5-7. See column 2, lines 22-39. The compositional ranges disclosed by the reference overlap the compositional ranges of instant claims 1, 2, and 5-7. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Prassas differs from the instant invention by teaching a photochromic glass comprising copper oxide.

Borrelli et al. teach a copper free polarizing glass wherein the glass contains elongated silver halide particles and said glasses do not exhibit photochromism. See Abstract of Borrelli et al. The reference teaches that copper is eliminated from the glass composition so that the glasses do not demonstrate photochromism. See column 1, lines 55-57. The reference teaches that cerium oxide is substituted for copper oxide to prevent the reduction of the silver ions to silver metal during heat treatments thus preventing photochromic behavior. See column 2, lines 47-66.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a glass of Prassas as suggested by Borrelli et al. because the resultant cerium substituted glass would have the polarizing effects Borrelli et al. without the photochromic properties of Prassas. See column 2, lines 47-66 of Borrelli et al.

Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita et al., U.S. Patent 3,998,647 in view of Borrelli et al., U.S. Patent 5,252,524.

Art Unit: 1755

Yamashita et al. teach a light sensitive glass having overlapping ranges of components with instant claims 1, 2, and 5-7. See Abstract of Yamashita et al. and specific examples 9-12 and 14-29. The compositional ranges disclosed by the reference overlap the compositional ranges of instant claims 1, 2, and 5-7. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05. See Abstract of Yamashita et al. and specific examples 9-12 and 14-29.

Yamashita et al. differ from the instant invention by teaching a photochromic glass comprising copper oxide.

Borrelli et al. teach a copper free polarizing glass wherein the glass contains elongated silver halide particles and said glasses do not exhibit photochromism. See Abstract of Borrelli et al. The reference teaches that copper is eliminated from the glass composition so that the glasses do not demonstrate photochromism. See column 1, lines 55-57. The reference teaches that cerium oxide is substituted for copper oxide to prevent the reduction of the silver ions to silver metal during heat treatments thus preventing photochromic behavior. See column 2, lines 47-66.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a glass of Yamashita et al. as suggested by Borrelli et al. because the resultant cerium substituted glass would have the polarizing effects Borrelli et al. without the photochromic properties of Yamashita et al. See column 2, lines 47-66 of Borrelli et al.

Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al., U.S. Patent 4,794,435 in view of Borrelli et al., U.S. Patent 5,252,524.

Art Unit: 1755

Suzuki et al. teach a photochromic glass having overlapping ranges of components with instant claims 1, 2, and 5-7. See Column 2, lines 53-65. The compositional ranges disclosed by the reference overlap the compositional ranges of instant claims 1, 2, and 5-7. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05. See Column 2, lines 53-65.

Suzuki et al. differ from the instant invention by teaching a photochromic glass comprising copper oxide.

Borrelli et al. teach a copper free polarizing glass wherein the glass contains elongated silver halide particles and said glasses do not exhibit photochromism. See Abstract of Borrelli et al. The reference teaches that copper is eliminated from the glass composition so that the glasses do not demonstrate photochromism. See column 1, lines 55-57. The reference teaches that cerium oxide is substituted for copper oxide to prevent the reduction of the silver ions to silver metal during heat treatments thus preventing photochromic behavior. See column 2, lines 47-66.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a glass of Suzuki et al. as suggested by Borrelli et al. because the resultant cerium substituted glass would have the polarizing effects Borrelli et al. without the photochromic properties of Suzuki et al. See column 2, lines 47-66 of Borrelli et al.

Response to Arguments

Applicants' arguments with respect to claims 1, 2, and 4-7 have been considered but are moot in view of the new ground(s) of rejection. Applicants' arguments directed towards Prassas, (U.S. 4,891,336) are addressed below as they pertain to the new rejection.

Art Unit: 1755

Applicants' argue that the glass taught by Prassas differs from instant claim 1 because the ratio content of K_2O to Na_2O and Li_2O is not present in Prassas. This is deemed not persuasive since Prassas teaches individual compositional ranges for Li_2O , Na_2O , and K_2O , as well as a combined compositional range for Li_2O , Na_2O , and K_2O . See column 2 lines 33-37.

Furthermore, Prassas teaches the compositional ratio for Li_2O/X_2O . See column 2, line 38. The compositional ranges for the alkali metal oxides disclosed by the reference overlap the compositional ranges of instant claim 1. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 703-305-0124. The examiner can normally be reached on 8:30am to 6:00 pm with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

EAB
August 21, 2003


DAVID SAMPLE
PRIMARY EXAMINER